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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/146,952 | 09/04/1998 | ATSUSHI INOUE | 040301/0539 | 1055 |

7590 09/30/2002
FOLEY & LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007-8696

EXAMINER

DUONG, DUC T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2663

DATE MAILED: 09/30/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.



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Office Action Summary

Application No.

09/146,952

Applicant(s)

INOUE ET AL.

Examiner

Duc T. Duong

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-24, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-24, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 9-11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Malkin et al (U.S. Patent 6,061,650).

Regarding to claim 9, Malkin discloses a mobile computer device capable of carrying out communications while moving over inter-connected networks, the mobile computer device comprising a registration transmission unit for registering an information on a current location of the mobile computer (col. 6 lines 1-2) and a transfer unit for transferring packets destined to the mobile computer to the current location of the mobile computer (col. 6 lines 31-35), a mobile computer management device 14 having a function for managing the information on the current location of the mobile

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computer device and transferring packets destined to the mobile computer device to the current location of the mobile computer device (Fig. 1 col. 2 lines 22-65), a user input unit (implicitly shown) for accepting a user input for user authentication (col. 3 lines 39-46), and a user-input-based information transmission unit 20 for transmitting to the mobile computer management device a response message containing information based on the user input as a user authentication information (Fig. 1 col. 3 lines 47-53), when a challenge message that requests returning of the user authentication information is received from the mobile computer management device in response to the registration message (col. 3 lines 31-38).

Regarding to claim 10, Malkin discloses the mobile computer further comprising an authentication unit 12 for judging a properness of the mobile computer management device according to the challenge message received from the mobile computer management device (Fig. 1 col. 2 lines 41-48), wherein the user-input-based information transmission 20 unit transmits the response message containing the information based on the user input when the mobile computer management device is judged as proper (col. 4 lines 15-37).

Regarding to claim 11, Malkin discloses the user input based information transmission unit 20 transmits the response message containing a one-time password based on a challenge code (col. 3 lines 35-38) contained in the challenge message received from the mobile computer management device as the user input based information (col. 4 lines 38-43).

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Regarding to claim 13, Malkin discloses the mobile computer, wherein the user input based information transmission unit transmits a password entered by a user at the mobile computer device as the user input based information (col. 3 lines 39-46).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12, 14-23, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malkin in view of Billstrom (U.S. Patent 5,729,537).

Regarding to claim 14, Malkin discloses a mobile computer device capable of carrying out communications while moving over inter-connected networks, the mobile computer device comprising a user authentication unit 12 for carrying out first user authentication locally at the mobile computer device according to the user information (Fig. 1 col. 2 lines 41-48), a registration message transmission unit for transmitting a registration message containing an information on a current location of the mobile computer device, from outside a home network of the mobile computer device to a mobile computer management device located at the home network (col. 5 lines 66-67 and col. 6 lines 1-2), a mobile computer management device 14 having a function for managing the information on the current location of the mobile computer device and

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transferring packets destined to the mobile computer device to the current location of the mobile computer device (Fig. 1 col. 2 lines 22-65), and a user-input-based information transmission unit 20 for transmitting to the mobile computer management device a user-input-based information to be used for second user authentication at the mobile computer management device (Fig. 1 col. 3 lines 46-53).

Malkin fails to teach for an external interface unit for reading out desired information from an external memory device connected to the mobile computer device, wherein the external memory device stores at least a user information and a network information to be used for communications at a visited site.

However, Billstrom discloses a mobile station includes a controller 24 (external interface unit) in operation (reading out desired information) with a Subscriber Identity Module SIM card 36 (external memory), wherein the SIM card stored information for mobile communication with network (Fig. 1 col. 6 lines 37-59).

Thus, it would have been obvious to one of ordinary skilled in the art, at the time of the invention, to includes the controller in operation with the SIM card as taught by Billstrom in Malkin's mobile device with the motivation for authorization of mobile communication in network.

Regarding to claims 15 and 16, Malkin discloses the mobile computer device, wherein the user authentication unit permits reading from the external memory device through the external interface unit and the user authentication unit permits transmission of the registration message by the registration message transmission unit when the first user authentication succeeds (col. 4 lines 58-65).

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Regarding to claim 17, Malkin discloses the mobile computer device, wherein the user information stored in the external memory device contains a personal information of a user who uses the mobile computer device, and the user authentication unit judges that the first user authentication succeeds when a user authentication information stored in the mobile computer device in correspondence to the personal information stored in the external memory device coincides with the user input as entered by the user at a time of connecting the external memory device to the mobile computer device (col. 3 lines 39-54).

Regarding to claims 12, 18, and 19, Malkin discloses the mobile computer further comprising a message transmission stopping unit (implicitly shown) for stopping subsequent transmissions of the registration message from the mobile computer device when a message indicating a failure of the user authentication is received from the mobile computer management device for a prescribed number of times consecutively (col. 5 lines 21-27). The termination of the PPP connection read on prohibiting subsequent reading from external memory device and stopping subsequent transmissions of the registration message.

Regarding to claims 20 and 21, Malkin in view of Billstrom discloses all the limitation with respect to claims 14 includes prohibiting subsequent reading from external memory device and stopping subsequent transmissions of the registration message when user authentication at the mobile computer management device fails for a prescribed number of times consecutively. However, Malkin with Billstrom fails to teach for a second user authentication. To include a second user authentication

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process of Malkin with Billstrom's device would have been obvious to one of ordinary skilled in the art since the process would accommodate more users.

Regarding to claim 22, Billstrom discloses the network information to be read out from the external memory device contains one or more destination address and information for authentication procedure (col. 6 lines 43-53).

Regarding to claim 23, Billstrom discloses the mobile computer, wherein the external memory device also stores a security information with respect to a packet relay device which is capable of processing encrypted packets transmitted from the mobile computer device, and the mobile computer device carries out cipher communications using an encryption processing from the visited site, by using the security information read out from the external memory device through the external interface unit (col. 9 lines 39-65).

Regarding to claims 29 and 30, Malkin discloses a storage medium having stored thereon instructions, which can be used to program a computer to perform the devices function (col. 7 lines 8-17).

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malkin in view of Perkins (U.S. Patent 5,159,592).

Regarding to claim 24, Malkin discloses all the limitation with respect to claim 14, except for an internal memory for temporarily storing the desired information read out from the external memory device, wherein the desired information temporarily stored in the internal memory is deleted when communications using the desired information is finished.

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However, Perkins discloses a mobile unit 10 maintains its assigned IP address until it is turned off, or until the network session is actively terminated (read on the IP address is temporarily stored so, but deleted after network session termination), see col. 5 lines 6-8. It is well known in the art IP address (desired information) stored in a table or memory.

Thus, it would have been obvious to one of ordinary skilled in the art, at the time of the invention, to included a memory for storing temporarily IP address and deleted after network session termination as taught by Perkins in Malkin's mobile device with the motivation for alternative storage and quick access to often use communication data.

Conclusion

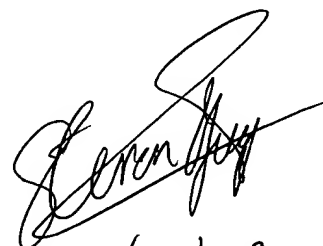
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is 703-605-5146. The examiner can normally be reached on M-Th (8:30 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on 703-308-5340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

DD

September 10, 2002



9/13/02